

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte APOSTOL KONOMI

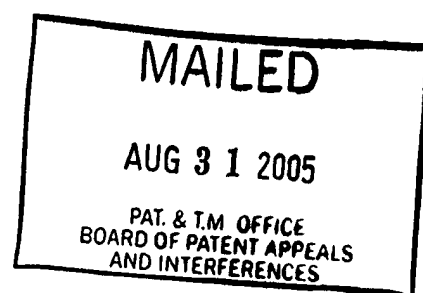
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Appeal No. 2005-1414  
Application 09/824,966

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ON BRIEF

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Before McQUADE, NASE, and BAHR, Administrative Patent Judges.

McQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Apostol Konomi appeals from the final rejection (mailed July 15, 2003) of claims 1 through 17 and 19, all of the claims pending in the application.

THE INVENTION

The invention relates to a double-sided edge-lit display box. Representative claim 1 reads as follows:<sup>1</sup>

Claim 1. A double-sided edge lighting-type display box comprising:

two display signage panels, having a desired design face;

at least two light sources offset from and behind said two display signage panels; and

a light directing panel located behind at least one of said two display signage panels;

whereby light directly incident on said at least one display signage from said at least two light sources and redirected light from said light-directing panel backlight and illuminate said two display signage panels, or at least one display signage panel.

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<sup>1</sup> The terms "the desired picture" in claim 3 and "the glass portion" in claims 11 and 13 lack a proper antecedent basis. Steps should be taken in the event of further prosecution to correct these informalities.

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THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Easterday et al. (Easterday)	1,931,577	Oct. 24, 1933
Murase et al. (Murase)	5,283,673	Feb. 01, 1994
Ashall	5,625,968	May 06, 1997

THE REJECTIONS

Claims 1 through 7, 9 through 17 and 19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Easterday in view of Ashall.

Claim 8 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Easterday in view of Ashall and Murase.

Attention is directed to the brief (filed March 29, 2004) and answer (mailed June 28, 2004) for the respective positions of

the appellant and examiner regarding the merits of these rejections.<sup>2</sup>

#### DISCUSSION

Easterday, the examiner's primary reference, discloses an illuminated sign comprising an aluminum case 10, a reflective liner 12 on the interior of the case, transparent or translucent sign panels 18 disposed for viewing on opposite sides of the case, an electric light bulb or similar illuminating means 14 offset from and behind the sign panels, conductors 15 extending into the case for supplying energy to the light bulb, and a V-shaped reflector 26 behind the sign panels and having a height substantially equal to that of the sign panels. According to Easterday,

since but a single electric light is normally used within casing 10, it is important that reflector 26 be flared adjacent each end thereof to present arcuate surfaces 36, all of which are utilized in directing the rays of light from illuminating means 14 toward and through the appropriate panel . . . 18 [page 2, lines 29 through 35].

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<sup>2</sup>The copies of claims 8 and 13 in the appendix to the brief do not reflect the amendments made to these claims in the paper filed December 16, 2002.

The examiner's determination that the illuminated sign disclosed by Easterday meets all of the limitations in independent claim 1 and dependent claims 2, 4, 5, 7, 9, 10, 12, 14 through 17 and 19 except for those in claims 1 and 9 requiring two light sources, those in claim 2 specifying the overall thickness of the claimed display box and those in claim 19 defining the light sources as elongated fluorescent bulbs is well founded. The appellant's various arguments to the contrary are unpersuasive because they are not commensurate with the actual scope of these claims. Such arguments fail from the outset because they are not based on limitations appearing in the claims. In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

To account for the admitted shortcomings of Easterday relative to the foregoing claims, the examiner turns to Ashall.

Ashall discloses a two-sided illuminated sign comprising a central transparent sheet 10, a light source 21 at one edge of the transparent sheet, a carrier 20 supporting the transparent panel and light source, and sign sheets 16 (and optionally 17) disposed on opposite sides of the transparent sheet. Ashall teaches that the light source may take the form of fluorescent

lights (see column 1, lines 15 through 18; and column 3, lines 53 and 54) and that larger signs may require an additional light source (see column 2, lines 15 through 17).

In proposing to combine Easterday and Ashall to reject the appealed claims, the examiner submits that it would have been obvious to one of ordinary skill in the art at the time the invention was made "to use the second light source of Ashall in the apparatus of Easterday et al. for providing additional light" (answer, page 4).

The test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. In re Keller, 642 F.2d 413, 425, 208 USPQ 871, 881 (CCPA 1981).

In the present case, Easterday clearly implies that an additional light source may be utilized ("a single electric light is normally used" (page 2, lines 29 and 30)) and Ashall expressly

states that an additional light source might be necessary to properly illuminate the sign disclosed therein. Such would have provided the artisan with ample suggestion or motivation to furnish Easterday's illuminated sign with a second light source for the self-evident reason expressed by the examiner, i.e., to provide the sign with additional light or illumination. Hence, the appellant's arguments that Easterday and Ashall would not have suggested this relatively simple and straightforward combination, and instead would have taught away therefrom, and that the proposed reference combination would result in an inoperative device are not convincing. Ashall also would have suggested the use of elongated fluorescent bulbs<sup>3</sup> as an art-recognized alternative to the exemplary electric light bulb disclosed by Easterday. As so modified in view of Ashall, the illuminated sign disclosed by Easterday would respond to all of the limitations in claims 1, 4, 5, 7, 9, 10, 12, 14 through 17 and 19.

As for the admitted failure of Easterday to teach the overall thickness of the claimed display box specified in claim 2, the examiner's conclusion (see pages 4 and 10 in the answer)

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<sup>3</sup>The appellant admits on page 5 in the underlying specification that such light bulbs are "standard."

that this thickness would have been obvious matter of design based on the size (thickness) of the light sources is reasonable on its face. Figure 2 in the Easterday reference clearly suggests such a relationship and the appellant's specification (see pages 4 through 6, 14 and 15) acknowledges that the specified thickness of the display box is a function of the size of standard light sources.

In view of the foregoing, we shall sustain the standing 35 U.S.C. § 103(a) rejection of claims 1, 2, 4, 5, 7, 9, 10, 12, 14 through 17 and 19.

We shall not sustain, however, the standing 35 U.S.C. § 103(a) rejection of dependent claims 3, 6, 11 and 13 as being unpatentable over Easterday in view of Ashall, or the standing 35 U.S.C. § 103(a) rejection of dependent claim 8 as being unpatentable over Easterday in view of Ashall and Murase.

Claim 3 requires the signage panels to be constructed of two sheets of plastic material, with a width of 2mm each, that allow the desired picture to be placed and held tightly between them.



Claim 6 calls for at least a portion of the light-directing panel to be substantially transparent.

Claim 11 defines the two signage panels as being substantially as tall as the glass portion of the two light sources.

Claim 13 recites the light-directing panel as having substantially the same height as the glass portion of the two light sources.

Claim 8 limits the distance between the light sources to be less than sixty-five percent of the length of the light sources.

As conceded by the examiner, Easterday does not respond to any of these limitations. The examiner's reliance on Ashall to overcome the deficiencies in Easterday with respect to claims 3, 6, 11 and 13 finds no support in the fair teachings of these references and clearly amounts to an improper hindsight reconstruction of the claimed subject matter. In the same vein, the examiner's citation of Murase to cure the shortcomings of


Easterday with respect to claim 8 rests on undue conjecture as to what Figure 6 of Murase shows with respect to the length and spacing of the light sources 14 depicted therein.


## SUMMARY

The decision of the examiner to reject claims 1 through 17 and 19 is affirmed with respect to claims 1, 2, 4, 5, 7, 9, 10, 12, 14 through 17 and 19, and reversed with respect to claims 3, 6, 8, 11 and 13.

AFFIRMED-IN-PART

  
JOHN P. McQUADE  
Administrative Patent

  
JEFFREY V. NASE  
Administrative Patent Judge

  
JENNIFER D. BAHR  
Administrative Patent Judge

BOARD OF PATENT  
APPEALS AND  
INTERFERENCES

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